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10/602,431

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David R. McCauley

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EXAMINER

MCCORMICK, GABRIELLE A

ART UNIT

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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,431	Applicant(s) MCCAULEY, DAVID R.	
	Examiner Gabrielle McCormick	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-17, 19, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-17, 19-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the Request for Continued Examination filed on July 9, 2008.
2. Claims 1, 17 and 20 have been amended.
3. Claims 5, 18 and 21 have been canceled.
4. Claims 1-4, 6-17, 19-20 and 22 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 6-17, 19-20 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lortscher et al. (US Pub. No. 2002/0111816 hereinafter referred to as "Lortscher").
7. **Claim 1:** Lortscher discloses:
 - *receiving a request to create a license, the license granting the first company the right to sublicense the information, the license obligating the first company to provide the consumer with a percentage of the monies that the first company receives for sublicensing the information;* (P[0021]: part of the fees collected by licensing is passed on to users (consumers) and P[0032]: Consumer responds agreeing to license personal information to subscribers (second company) of the privacy system (first company))
 - *receiving the information;* (P[0021]: user provides information)
 - *sublicensing the information to a second company (P[0032]) wherein the information is sublicensed to the second company without obtaining the consumer's consent;* (P[0037]:

user sets access control and the level of sharing that can be specific to a subscriber company or a group of subscribers by industry, therefore, the companies or industries that are granted access during the set-up have access to the user's information without needing to obtain consent from the user.)

- *providing the consumer with the percentage of the monies received for sublicensing the information to the second company.* (P[0046]: "Licensing rule may include paying a fixed percentage of the privacy system operator's revenue to each user of the system.")
8. Lortscher further discloses obtaining information from product surveys and from consumer responses as well as obtaining personal preferences such as hobbies, favorite book and magazines they've read (P[0020]), thus the information requested and received includes *areas of interest for the consumer*.
9. Lortscher does not explicitly disclose receiving detailed information related to the areas of interest, however, it is obvious that is including the gathering of psychometric data that includes personal preferences (P[0020]) that detailed information relating to these preferences is received. For example, Lortscher discloses obtaining preferences such as hobbies and favorite books. It is obvious that details regarding the frequency of participating in a hobby or the titles of books and genres would be collected.
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included detailed information in the system of Lortscher for the motivation of gathering consumer specific data that allows better targeted advertising. As information becomes increasing consumer specific, such through gathering personal information and details, targeted advertising results in higher sales and the system of Lortscher would be motivated to obtain this more detailed information in order to increase profits.
11. **Claims 17 and 20:** Lortscher discloses:
- *receiving a request to create a license, the license granting the first company the right to sublicense the information,* (P[0021]: part of the fees collected by licensing is passed on to

- users (consumers) and P[0032]: Consumer responds agreeing to license personal information to subscribers (second company) of the privacy system (first company))
- *the license obligating the first company to provide the consumer with a first percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a certain time period and a second percentage of the monies that the first company receives for sublicensing the information if the consumer does not update the information within the certain time period; (P[0047]: "incentives may decline over time where the user does not update their information frequently" and P[0048]: "a percentage sharing rule with a declining fee schedule" and "declining fee schedule...create(s) an incentive for each user to update or verify their licensed information.")*
 - *receiving the information; (P[0021]: user provides information)*
 - *sublicensing the information to a second company (P[0032]) wherein the information is sublicensed to the second company without obtaining the consumer's consent; (P[0037]: user sets access control and the level of sharing that can be specific to a subscriber company or a group of subscribers by industry, therefore, the companies or industries that are granted access during the set-up have access to the user's information without needing to obtain consent from the user.)*
 - *providing the consumer with either the first percentage or the second percentage of the monies received for sublicensing the information to the second company. (P[0046]: "Licensing rule may include paying a fixed percentage of the privacy system operator's revenue to each user of the system.")*
12. Lortscher further discloses obtaining information from product surveys and from consumer responses as well as obtaining personal preferences such as hobbies, favorite book and magazines they've read (P[0020]), thus the information requested and received includes *areas of interest for the consumer*.
13. Lortscher does not explicitly disclose receiving detailed information related to the areas of interest, however, it is obvious that is including the gathering of psychometric data that includes

personal preferences (P[0020]) that detailed information relating to these preferences is received. For example, Lortscher discloses obtaining preferences such as hobbies and favorite books. It is obvious that details regarding the frequency of participating in a hobby or the titles of books and genres would be collected.

14. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included detailed information in the system of Lortscher for the motivation of gathering consumer specific data that allows better targeted advertising. As information becomes increasing consumer specific, such through gathering personal information and details, targeted advertising results in higher sales and the system of Lortscher would be motivated to obtain this more detailed information in order to increase profits.
15. **Claim 2:** Lortscher discloses providing licensing percentages of 75, 60 and declining to a floor of 10% as examples of how a percentage sharing schedule. (P[0048]). Lortscher does not disclose 40%. However, it is inherent that as the fee schedule declines from 60 to 10%, 40% would become the percentage of licensing fee.
16. **Claims 3 and 4:** Lortscher discloses obligating *the first company to provide the consumer with a first percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a first period of time, and a second percentage of the monies that the first company receives for sublicensing the information if the consumer updates the information within a second period of time.* (P[0047]: “incentives may decline over time where the user does not update their information frequently” and P[0048]: “a percentage sharing rule with a declining fee schedule” and “declining fee schedule...create(s) an incentive for each user to update or verify their licensed information.”)
17. Lortscher does not disclose a percentage if the consumer does not update the information or that the second period of time is greater than the first period of time.
18. However, it is obvious if the consumer never updates his/her information, a reduced licensing fee would result, as well as if the consumer becomes more and more tardy in updating his/her

- information. Lortscher discloses using declining license fee percentages as a means of creating an incentive for each user to update their information.
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included percentages based on updating activity and lack of updating activity in Lortscher's system for the motivation of providing a method of incenting users to keep information timely and up-to-date. (Lortscher; P[0048]).
20. **Claims 6, 19 and 22:** Lortscher discloses obtaining consent of the user based on the industry of the second company. (P[0037]: User preferences set access controls (gathering of user preferences to set access controls inherently requires consent of the user) to the information database; a user may want his information available to companies in certain industries and P[0038]: subscribers agree not to disclose without permission from the user).
21. **Claim 7:** Lortscher discloses that information includes demographic information including census bureau information (inherently includes marital, family and address information) and financial information including income.
22. **Claims 8, 9 and 10:** Lortscher discloses receiving information via the Internet (P[0025]), telephone and handheld device (P0024]).
23. **Claim 11:** Lortscher discloses receiving personal preference information such as hobbies, books and magazines. (P[0020]).
24. **Claim 12:** Lortscher discloses an email (P[0032]) with a hyperlink (P[0040]: consumers send (email) hyperlinked letters).
25. **Claim 13:** Lortscher discloses creating license prior to providing information. (P[0032]: user responds creating license and an additional authorization to collect personal information from a third party about the user. This additional information is collected after the licensing agreement is created.)
26. **Claims 14, 15 and 16:** Lortscher discloses creating the license (S.60) after information retrieval (S.50) (both from Fig. 4) and basing the license on terms in the information (P[0037]: the "terms"

provided by Lortscher include user preferences such as access by company, industry, company policy, offer delivery channels and fee schedule).

Response to Arguments

27. Applicant's arguments with respect to claims 1, 17 and 20 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argued that the prior art of record does not disclose the limitations added to the amended claims 1, 17 and 20. The Examiner has provided the analysis of the prior art with respect to these limitations in the rejections above.
28. The Examiner consulted the Applicant's specification to construe how information is sublicensed without obtaining the consumer's consent. Per P[0065], the consumer's licensing agreement stipulates sublicensing of information to industries that a consumer specifies without obtaining the consumer's consent, i.e., the consumer consent to share the information is provided upfront. Lortscher discloses a similar procedure where during the user's account setup, the user sets access control and sharing preferences wherein a user can make his information available to companies in certain industries. Thus, the access of the user information by the companies in those specified industries is established upfront and therefore without the need of the user's consent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629